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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,236	03/30/2001	Hai Chi Nguy	Q01-1025-US1/11198.64	6324

7590 06/09/2005
Steven G. Roeder
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EXAMINER

DAVIS, DAVID DONALD

ART UNIT PAPER NUMBER

2652

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/823,236		NGUY, HAI CHI	
	Examiner		Art Unit	
	David D. Davis		2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 16-24, 26 and 29-50 is/are pending in the application.
- 4a) Of the above claim(s) 16-24, 26, 32, 35 and 37-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 29-31, 33, 34, 36 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20050526</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of applicant's oral request to issue a new Final Office Action in the telephonic interview May 18, 2005 and in view applicant's written request received May 24, 2005 to revise the Restriction Requirement mailed October 8, 2003, the following action is set forth, *infra*, in order to expedient prosecution of the instant application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 26, 32, 35, 37-47, 45 and 46, drawn to housing shield attenuating a field and having a material with a relative permeability, classified in class 360, subclass 97.02.
 - II. Claims 10, 29-31, 33, 34, 36 and 48-50, drawn to a housing attenuating a field, classified in class 360, subclass 97.02.
 - III. Claims 16-24, drawn to a housing having a material with a relative permeability, classified in class 360, subclass 97.02.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination has housing shield portions formed from material having a

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relative permeability of at least approximately 100,000. The subcombination has separate utility such as providing an attenuation of field of at least 25 dB that at least partially shields the storage surface from an external magnetic field that is applied in a direction that is substantially perpendicular to the storage surface.

4. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination has housing shield portions having an attenuation of field of at least approximately 50 dB. The subcombination has separate utility such as providing a housing shield being formed from material having a relative permeability of at least approximately 50,000.

5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as providing an attenuation of field of at least 25 dB that at least partially shields the storage surface from an external magnetic field that is applied in a direction that is substantially perpendicular to the storage surface. See MPEP § 806.05(d).

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6. Because these inventions are distinct for the reasons given above and the search required for Groups I and II is not required for Group III; the search required for Groups II and III is not required for Group I; and the search required for Groups I and III is not required for Group II restriction for examination purposes as indicated is proper.

7. Claims 16-24, 26, 32, 35, 37-47, 45 and 46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 10, 2003.

8. Applicant's election with traverse of Group II in the reply filed on November 10, 2003 is acknowledged. The traversal is on the ground(s) that some claims need to be grouped with other claims. This is not found persuasive because the reasons set forth in the previous office action show that the groupings are independent and distinct. In other words, the groupings are related as combination, subcombination or combinations useable together.

The requirement is still deemed proper and is therefore made FINAL.

9. This application contains claims drawn to an invention nonelected with traverse in Paper No. 8, received November 10, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 10, 29-31, 33, 34, 36 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM Technical Disclosure Bulletin, November 1990 (hereinafter: IBM) in view of Nakazawa et al (JP 10-69763). IBM shows a drive housing for a disk drive 2 having a storage disk having a storage surface. IBM also shows a housing shield 1 positioned near the storage disk. The housing shield is sized, shaped and formed from material so that the housing shield has an attenuation of field of at least approximately 50 dB because IBM states that the attenuation is 30 db or greater.

IBM, however, is silent as to the drive housing including a shield.

Nakazawa et al shows in figure 1 the drive housing including a shield that is equally spaced in a direction that is substantially perpendicular to the storage surface of the storage disk, as well as the direction parallel to the storage surface. Nakazawa et al also shows in figure 1 the drive housing including a base and a cover that are positioned substantially parallel to the storage surface. The storage disk would be positioned substantially between the base and the cover, as shown in figure 1.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to include in the housing of IBM a shield as taught by Nakazawa. The rationale is as follows: one of ordinary skill in the art at the time the invention was made would

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have been motivated to provide housing a shield so as to enable "effective isolation of flux inside and outside of case, due to use of case and cover consisting of electromagnetic shielding". See Derwent Abstract of Nakazawa.

Response to Arguments

12. Applicant's arguments filed June 30, 2003 have been fully considered but they are not persuasive. In the first full paragraph on page 12, applicant asserts, "IBM does not teach or suggest a disk drive that includes a drive housing and a storage disk that is rotatably mounted to the drive housing." It should be noted that the rejection *supra* is not an anticipation rejection over IBM but an obviousness rejection over IBM as modified by Nakazawa. Therefore, the assertion that IBM alone does not teach or suggest the claimed invention is not germane to the rejection *supra*. It also should be noted, contrary to applicant suggestion, the IBM reference is analogous art and relevant to the claimed invention.

Applicant also asserts, in the second paragraph on page 12, that "IBM only discloses obtaining a certain level of attenuation as a result of the dimensions of the enclosure, not the materials used." The claimed invention does not require attenuation by materials used, nor does it preclude attenuation by dimensions. Applicant continues to assert in the second paragraph on page 12 that "IBM teaches an attenuation of filed in the vertical direction of 10-15 dB, and in the horizontal direction of > 30 dB based on the space provided by the enclosure relative to the peripheral device." Applicant is not incorrect in the characterization of IBM. However, as stated *supra*, the rejection is over IBM as modified by Nakazawa. Nakazawa does not show any substantial spacing. In fact, the entire housing is made from shielding. Therefore, since there is

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no spacing it would follow that the attenuation in *all* directions, utilizing the attenuation arrangement of IBM in the housing arrangement of Nakazawa as outlined supra, would be much greater than > 30 dB. As a result, contrary to applicant piecemeal assertions, IBM as modified by Nakazawa renders the claimed invention obvious.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

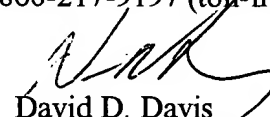
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Davis whose telephone number is 571-272-7572. The examiner can normally be reached on Monday thru Friday between 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David D. Davis
Primary Examiner
Art Unit 2652

ddd